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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

FINGERHUT

Group Art Unit: 2686

Application No. 09/921,272

Examiner: LY, Nghi H

Filed: August 1, 2002

Docket: BS00186

Title: "Methods and Systems for Selective Broadcast Enhancement"

37 C.F.R. § 1.8 CERTIFICATE OF TRANSMISSION & MAILING

I hereby certify that this correspondence is being communicated via facsimile on the date below. I also certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

Scott P. Zimmerman
Name of Person Mailing This Paper

[Signature]
Signature

25 OCT 2004
Date of Mailing/Transmission

**37 C.F.R. § 1.143 Request for Reconsideration
of Requirement for Restriction**

Mail Stop: Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Commissioner:

This paper is filed in response to the first Office Action, mailed September 28, 2004, in the above-identified application. The United States Patent and Trademark Office ("Office") imposed a restriction requirement. Assignee hereby requests reconsideration and withdrawal of this restriction requirement. PLEASE NOTE THIS RESPONSE WAS FAXED ON OCTOBER 25, 2004. No confirmation return fax was received, so this mailed response is a DUPLICATE.

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PROVISIONAL ELECTION

The Office alleges that this patent application contains five (5) groups of patentably distinct species. As 37 C.F.R. § 1.143 requires, the Assignee provisionally elects the Group I claims of 1-10 and 46-49.

REPLY AND TRAVERSAL

The Assignee respectfully requests reconsideration and withdrawal of this restriction requirement. The Assignee traverses this restriction requirement by relying upon the following reasons.

1. No Showing of Independent or Distinct Inventions

The Office makes no attempt to show the claims are independent or distinct. One criterion for restriction is that the alleged inventions in a single application must be independent or distinct. *See* U.S. DEPT. OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 803 (8th Ed. 2001). The Office must provide reasons and/or examples to support the requirement of restriction. *See id.*

The Office has failed to satisfy this criterion. The restriction requirement offers no explanation, nor reasoning, to support the requirement of restriction. The Office offers no discussion of how, or why, the claims are independent or distinct. The Office merely states "inventions II, III, IV, and V have separate utility." The office action then quotes different claim limitations, but there is no explanation, nor reasoning, that supports why these different claim limitations support restriction. This restriction requirement, then, is improper and must be withdrawn.

Maintaining this restriction is a violation of due process. If the Office wishes to factually support a restriction, a second office action is required. This second office action must follow the requirements of § 803 of the MPEP. This second office action also cannot maintain the restriction requirement — this second office action may ONLY properly present the reasons for a restriction. Once the Office properly follows § 803, and properly supports a restriction

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requirement, the Assignee must be given another opportunity to rebut the restriction requirement. ANY OTHER ACTION IS A VIOLATION OF DUE PROCESS.

2. No Showing of Burden

The Office provides no *prima facie* showing of serious burden. Another criterion for restriction is that there must be a "serious burden" on the Examiner. See U.S. DEPT. OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 803 (8th Ed. 2001). The Office may make a *prima facie* case for restriction, using "appropriate explanation," of i) separate classification, ii) a separate status in the art, or iii) a different field of search. *Id.* See also *id.* at § 808.02.

The Office makes no attempt at a *prima facie* case. The Office makes no mention of any burden on the Examiner. The office action does list the class and subclass for each grouping, but the Examiner makes no mention of any burden. The Assignee, in fact, notes that all the alleged groupings have the same major classification (class 455) and only different sub-classifications. Nearly all inventions, and prior art searches, have multiple sub-classifications. Because the Office makes no attempt to satisfy their *prima facie* burden, the restriction requirement is improper and must be withdrawn.

Maintaining this restriction is, again, a violation of due process. The Office makes no attempt to satisfy their legal duty. The Office must provide reasons for a restriction, and the Office must give the Assignee an opportunity to rebut. Once the Office properly shows a burden exists on the Examiner, the Assignee must be given another opportunity to rebut the restriction requirement. ANY OTHER ACTION IS A VIOLATION OF DUE PROCESS.

3. Reasoning Is Inadequate

The reasons relied upon by the Office are inadequate. The Office must concisely state the reasons for alleging either an independent or a distinct invention. See U.S. DEPT. OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 816 (8th Ed. 2001). "A mere

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statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given." *Id.*

Here, however, no reasoning whatsoever is given. The Office has made mere conclusive statements without any supporting reasons. This restriction requirement, then, is not proper and must be withdrawn. ANY OTHER ACTION IS A VIOLATION OF DUE PROCESS.

The Office, in summary, has improperly imposed a restriction requirement. The Office wholly fails in their procedural duty. The Office makes no attempt to show the claims define independent inventions or distinct inventions, the Office provides no *prima facie* showing of serious burden on the Examiner, and the Office fails to provide supporting reasons. This restriction requirement, then, is a violation of due process and must be withdrawn.

If the Office has any questions, the Office is invited to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,



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Attorney for Assignee